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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051279
Party	Plaintiff Red Hen Bread LLC
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ATTORNEYS FOR PETITIONER

TABLE OF CONTENTS

	PAGE
TABLE OF CONTENTS.....	2
INDEX OF CASES.....	3
I. STATEMENT OF ISSUE.....	5
II. DESCRIPTION OF THE RECORD.....	6
III. RELEVANT FACTS.....	7
IV. STATEMENT OF LAW AND ARGUMENT.....	8
A. Petitioner Has Standing and Priority is Not an Issue.....	8
B. The duPont Factors Which Weigh in Favor of Finding Confusion Likely.....	8
1. The Goods Identified in the Subject Registration and the Petitioner's Goods are Overlapping and Closely Related.....	8
2. Because These Goods Are Legally Identical, They Must Be Deemed To Be Sold in The Same Channels of Trade.....	9
3. The Dominant Element of the Marks is Identical and the Marks as a Whole are Confusingly Similar.....	10
4. Any Doubts are Resolved in Favor of Senior User.....	12
C. Respondent Has Not Used His Mark on the Named Goods in Commerce.....	12
V. CONCLUSION.....	15

INDEX OF CASES

<u>CASES</u>	<u>PAGE</u>
<u>Barbara's Bakery, Inc. v. Landesman</u> 82 USPQ2d 1283, 1288 (TTAB 2007).....	10
<u>Century 21 Real Estate Corp. v. Century Life of America,</u> 970 F.2d 874, 877 (Fed. Cir. 1992).....	9, 11
<u>Federated Foods, Inc. v. Fort Howard Paper Co.,</u> 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).....	8
<u>Hewlett-Packard Co. v. Packard Press, Inc.,</u> 281 F.3d 1261, 1267 (Fed. Cir. 2002).....	9
<u>In re Bagel Factory, Inc.,</u> 183 USPQ 553, 554, 555 (TTAB 1974).....	15
<u>In re Continental Graphics Corp.,</u> 52 USPQ2d 1374, 1377 (TTAB 1999).....	10
<u>In re E.I.du Pont de Nemours & Co.,</u> 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).....	8
<u>In re Elbaum,</u> 211 USPQ 639, 640 (TTAB 1981).....	10
<u>Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.,</u> 823 F. 2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).....	8
<u>Kangol, Ltd. v. KangaROOS U.S.A., Inc.,</u> 974 f. 2D 161, 23 uspq2D 1945 (Fed. Cir. 1992).....	11
<u>Lipton Industries, Inc. v. Ralston Purina Co.,</u> 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).....	8
<u>Meridian Mutual Insurance Co. v. Meridian Insurance Group, Inc.,</u> 128 F.3d 1111, 44 USPQ2d 1545 (7th Cir. 1997).....	11
<u>Octocom Sys., Inc. v. Houston Computer Services, Inc.,</u> 918 F.2d 937, 942 (Fed. Cir. 1990).....	9
<u>Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En,</u> 73 USPQ2d1689, 1692 (Fed. Cir. 2005).....	10
<u>Paula Payne Products Co. v. Johnson Publishing Co.,</u> 177 USPQ 76 (CCPA 1973).....	10

<u>Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation</u> 206 USPQ 255 (TTAB 1980).....	12
<u>Ritchie v. Simpson,</u> 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).....	8
<u>Tuxedo Monopoly, Inc. v. General Mills Fun Group,</u> 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).....	9

I. STATEMENT OF ISSUES

Respondent Norm Oeding has admitted that Petitioner Red Hen LLC has priority and has established standing.

Respondent, in his answer to petitioner's amended petition to cancel, admitted to the following:

a) Petitioner has adopted and continuously used the trademark RED HEN BREAD since at least as early as December 9, 1996 to the present, in connection with bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries.

b) Petitioner has filed an application to register the mark RED HEN BAKERY ("Petitioner's Mark") for "bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries" in International Class 30. This application, which is based on the petitioner's use of this trademark in commerce in connection with the named goods in Class 30 since at least as early as December 9, 1996, was filed April 6, 2009, and is identified by Serial No. 77/707,868. The U.S. Patent and Trademark Office has refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because "of a likelihood of confusion with the mark in U.S. Registration No. 3,614,763 as to be likely to cause confusion, to cause mistake, or to deceive as to the source of the goods."

c) There is no issue as to priority of use. Petitioner has continuously used its RED HEN BREAD trademark since at least as early as December 9, 1996, which is prior to the March 16, 2008 filing date for U.S. Trademark Application Serial No. 77/423,259, which matured into Registration No. 3,614,763, and prior to the August 29, 2005 first date of use alleged by the Registrant.

d) Registrant did not make use of the LITTLE RED HEN BAKERY mark on all of the goods identified in his use-based application at least as early as the filing date of the underlying application for Registration No. 3,614,763.

e) Registrant did not make use of the LITTLE RED HEN BAKERY as a trademark on all of the goods identified in Registration No. 3,614,763 in interstate commerce prior to or on the filing date of the underlying use-based application for Registration No. 3614763.

The remaining issues are: 1) whether there is a likelihood of confusion between the petitioner's mark RED HEN BREAD, which has been used since at least as early as December 9, 1996, on or in connection with 'bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries,' and the respondent's mark LITTLE RED HEN BAKERY for "fresh, baked bread products, namely, bread, buns, bagels, bread rolls and baguettes," which is the subject of U.S. Trademark Registration No. 3614763; and 2) whether the respondent used LITTLE RED HEN BAKERY as a trademark in connection with the products named in the subject registration in interstate commerce on or before the filing date of the application to register the subject trademark.

II. DESCRIPTION OF THE RECORD

Petitioner timely filed its Petition to Cancel on July 27, 2009.

Respondent filed his Answer on September 4, 2009.

By motion dated February 1, 2011, petitioner filed its Amended Petition to Cancel. This motion was granted and the Amended Petition became controlling.

Respondent filed his Amended Response to Petitioner's Amended Petition to Cancel on May 24, 2011.

Petitioner took written discovery in the form of interrogatories and requests for production of documents. Petitioner did not take any oral discovery.

Respondent did not take any written or oral discovery.

On September 23, 2011, petitioner filed its Notice of Reliance with respondent's answers to Petitioner's First Set of Interrogatories Nos. 1, 3, 4(d), 6, and 12, and copy of June 23, 2009 office action issued June 23, 2009, located in the USPTO's TDR prosecution history documents for Serial No. 77707868 (Petitioner's application to register RED HEN BREAD), by which the examining attorney refused registration based on the existence of Registration No. 3,614,763.

Respondent did not take any testimony and did not file any notices of reliance.

III. RELEVANT FACTS

Since at least as early as December 9, 1996, petitioner has continuously used the trademark RED HEN BREAD in connection with bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries.

On March 16, 2008, Respondent Norm Oeding filed an application to register the mark LITTLE RED HEN BAKERY for "fresh, baked bread products, namely, bread, buns, bagels, bread rolls and baguettes" in International Class 30. This application, which was identified by Serial No. 77/423,259, was filed based on an alleged August 29, 2005 first date of use. On May 5, 2009, this application matured into registration as Registration No. 3,614,763.

On April 6, 2009, Petitioner filed an application to register its RED HEN BREAD trademark for "bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries" in International Class 30 with the U.S. Patent and Trademark Office. This application, which is identified by Serial No. 77/707,868, is based on the petitioner's continuous use of this trademark in connection with the named goods in commerce since at least as early as December 9, 1996. By office action dated June 23, 2009, registration of the petitioner's mark was refused "because of a likelihood of confusion with the mark in U.S. Registration No. 3614763." The examining attorney stated, "The applicant's mark is RED HEN BREAD. The registered mark is LITTLE RED HEN BAKERY. The marks are likely to create the same commercial impression in the minds of consumers, as they share the common wording RED HEN." The examining attorney further

stated, "The goods of the parties are closely related in that the applicant and the registrant are both providing bakery goods including bread, buns, bagels, bread rolls and baguettes."

IV. STATEMENT OF LAW AND ARGUMENT

A. Petitioner Has Standing and Priority is Not an Issue

To establish standing to petition to cancel respondent's registration, petitioner must prove that it has a real interest in the outcome of this proceeding and, thus, a reasonable basis for its belief that it would be damaged by the registration. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Respondent has admitted that petitioner's application to register its RED HEN BREAD trademark was refused registration based on the subject registration. As a result, petitioner has established standing.

The parties have stipulated that priority is not an issue based on respondent's admission that petitioner has priority.

B. The *duPont* Factors Weigh in Favor of Finding Confusion Likely

The relevant standard for determining likelihood of confusion is established in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The most significant of the *duPont* factors here are the similarity between the marks and the similarity between the goods, but the overlap in customers and trade channels also weigh in favor of finding confusion likely.

1. The Goods Identified in the Subject Registration and the Petitioner's Goods are Overlapping and Closely Related.

In determining the degree of similarity of the goods or services of the parties, the Board considers the goods or services as set forth in the involved application and registration. It does not read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990).

The goods listed in the subject registration are “fresh, baked bread products, namely, bread, buns, bagels, bread rolls and baguettes.” As respondent has admitted, petitioner uses, and has continued to use its RED HEN BREAD trademark on or in connection with its bakery products, namely, bread, buns, bagels, bread rolls, baguettes, croissants, cookies, muffins, scones, Danish, tarts and assorted pastries (“petitioner’s goods”) since at least as early as December 9, 1996. The goods for which respondent has obtained registration for the designation LITTLE RED HEN BAKERY are, indisputably, identical to the goods sold by petitioner under its RED HEN BREAD trademark. There is no genuine issue of material fact regarding the similarity of the parties’ goods. They should be presumed identical. Hence, this *du Pont* factor overwhelming favors a finding of likelihood of confusion.

When, as here, the marks are used on the same goods, then the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877 (Fed. Cir. 1992). See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

2. Because These Goods Are Legally Identical, They Must Be Deemed To Be Sold in The Same Channels of Trade.

Where there is no limitation on the channels of trade in the identification of goods in the subject registration, it is presumed that the identification encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all

potential customers. *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999). Because the goods recited in the subject registration are identical to the ones sold by petitioner under its RED HEN BREAD trademark, the channels of trade must be deemed to be the same. Prospective purchasers of these bakery items are ones that can be deemed to be ordinary purchasers, who apply an ordinary standard of care to purchasing decisions. *Paula Payne Products Co. v. Johnson Publishing Co.*, 177 USPQ 76 (CCPA 1973).

Furthermore, because there are no restrictions in either petitioner's or respondent's identification of goods as to the channels of trade in which the goods may be encountered, or type or class of customer to whom the goods are marketed, both petitioner's and respondent's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Hence, this *du Pont* factor favors a finding of likelihood of confusion.

3. The Dominant Element of the Marks is Identical and the Marks as a Whole are Confusingly Similar.

"In cases such as this, where the applicant's (registrant's) goods are identical to the opposer's (petitioner's) goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical." *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1288 (TTAB 2007). To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these bases for comparison may be critical in finding marks to be similar. Petitioner's mark is RED HEN BREAD and registrant's mark is LITTLE RED HEN BAKERY. The dominant portion of the parties' marks, i.e., RED HEN, is

identical in appearance, and completely identical in sound and meaning. The remaining elements of registrant's mark are either a modifier (LITTLE) of the dominant term (RED HEN) or descriptive and disclaimed (BAKERY). The additional element of the petitioner's mark BREAD is generic for its goods and accordingly has little commercial significance. The addition of these terms for the respective goods offered under each mark does not serve to significantly distinguish the marks overall, particularly since the goods themselves are the same. "A particular feature of a mark may be more obvious or dominant, and therefore, when determining likelihood of confusion, greater weight ought to be given to the force and effect of such a feature." *Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). "In comparing two marks to determine whether they are confusingly similar, this Circuit follows the rule that 'if one word or feature of a composite trademark is the salient portion of the mark, it may be given greater weight than the surrounding elements.'" *Meridian Mutual Insurance Co. v. Meridian Insurance Group, Inc.*, 128 F.3d 1111, 44 USPQ2d 1545 (7th Cir. 1997). The similarities in sight, sound, connotation and commercial impression for LITTLE RED HEN BAKERY for baked bread products and RED HEN BREAD for baked bread products are substantial.

The Court of Appeals for the Federal Circuit has held that when marks appear, as is the case herein, on "virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather, the decision must be based on the similarity of the

general overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

Based on the similarities in the sight, sound, connotation and commercial impression between the petitioner's mark and the registrant's mark, this *du Pont* factor favors a finding of likelihood of confusion.

4. Any Doubts are Resolved in Favor of Senior User

Any doubt as to the likelihood of confusion is properly resolved in favor of the prior user. Respondent has admitted that petitioner has priority. Petitioner has long and continuously used its RED HEN BREAD trademark and trade name prior to any date claimed by the respondent. There is recognition of the RED HEN BREAD mark and name among the relevant public. Respondent has admitted to this fact. In the circumstances, there is no need for the respondent to create a likelihood of confusion with petitioner's mark and name. The relevant *duPont* factors for which there is evidence weigh heavily in favor of finding confusion likely.

C. Respondent Has Not Used His Mark on the Named Goods in Commerce.

Respondent, in his answer, has admitted that he did not make use of the LITTLE RED HEN BAKERY mark on all of the goods identified in his use-based application at least as early as the filing date of the underlying application for Registration No. 3,614,763, and has admitted that he did not make use of the LITTLE RED HEN BAKERY mark on all of the goods identified in Registration No. 3,614,763 in interstate commerce prior to or on the filing date of the underlying use-based application for Registration No. 3,614,763.

Respondent Norm Oeding is a one man isolated operation, whose business address, as indicated on the subject registration, is located in Newton, Kansas.

In response to Interrogatory No. 1 – Identify each person whom you know or believe to have knowledge of any fact or matter relevant to the subject matter of this proceeding and briefly describe the nature or subject matter of that person's knowledge, the response reads, "Norm Oeding has knowledge of all aspects of the production and marketing of Little Red Hen Bakery products." No other person is identified as having knowledge to any fact relevant to the subject matter of this proceeding, namely, use of the mark LITTLE RED HEN BAKERY.

In response to Interrogatory No. 3 – Identify each natural person currently or previously employed by Registrant who possesses knowledge, information or is primarily responsible for the marketing, actual sales of products bearing the mark LITTLE RED HEN BAKERY and potential sale of products bearing the mark LITTLE RED HEN BAKERY including, but not limited to, the persons responsible for the sale of each separate line or category of products sold under or using the mark LITTLE RED HEN BAKERY in the United States for each year from the first date of sale or distribution until the present, the response reads, "None." Mr. Oeding has not had and does not have any employees, past or present, who possess knowledge or information about the sales or marketing of LITTLE RED HEN BAKERY products.

In response to Interrogatory No. 6 – Identify any third party employed or consulted in connection with promoting, advertising, marketing, launching, or announcing the goods sold under or in connection with Registrant's mark, the response reads, "There are no such third parties."

In response to Interrogatory No. 12 – Identify each distributor outside of Kansas for each product bearing Registrant's Mark since the date of first sale or distribution, the response reads, "Mr. Oeding has no distributors outside of Kansas."

The geographic areas in which LITTLE RED HEN BAKERY products have been sold and distributed are limited to the following retail establishments, which are all located in Sedgwick County, Wichita and Goodard, Kansas and Kingman County, Kingman, Kansas: Kansas Grown Farmer's Market – Wichita, KS, Sedgwick County, White's Foodliner, Kingman, KS, Kingman County, White's Foodliner, Goodard, KS, Sedgwick County, Jim's Foodliner, Cheney, KS, Sedgwick County, Food For Thought Natural Foods Market, Wichita, KS, Sedgwick County, and Whole Foods Association of Wichita, Wichita, KS, Sedgwick County. See respondent's response to Interrogatory No. 4(d).

Ownership of a mark arises or grows out of use. Use on or in connection with goods sold within a single state is sufficient to confer ownership and common law rights therein to said user. But, such ownership or rights in and to a mark cannot be recognized for registration purposes under the federally enacted Lanham Act unless and until there has been movement of the trademark product in more than one state, in commerce with foreign countries or within the territories of the United States. That is, the mark must, at the time of the filing of the (use-based) application for registration, be in use in commerce.

Section 45 of the statute defines "Use in commerce" as:

"For the purposes of this Act a mark shall be deemed to be used in commerce (a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce."

Respondents goods, fresh, baked bread products, admittedly are sold to retail establishments in only one state, namely, Kansas. When respondent's products were sold to the retail establishments or to customers in the retail establishments, the sales transactions were completed, title passed to the customers, and respondent's dominion and control thereover ceased to exist at that time. Any subsequent transportation of that product across stateliness is an independent act of said purchaser and, as such, cannot inure to respondent's benefit. The proprietor of a retail store would not ordinarily know the final destination of a product sold over-the-counter for use or consumption off the premises. *In re Bagel Factory, Inc.*, 183 USPQ at 555. As a result, respondent's mark was not in use "in commerce" on the date alleged in the underlying application and the subject registration should be deemed void.

V. CONCLUSION

Because the petitioner's and respondent's marks are substantially similar, the petitioner's goods and the goods identified in the subject registration are identical and/or otherwise similar, and the goods are presumed to travel in the same channels of trade to the same classes of purchasers, there should be a finding, considering the *duPont* factors, that the applicant's mark is likely to cause confusion with opposer's registered mark.

The conclusive evidence established by Opposer's registration, coupled with the identical goods and similar marks confirms that a likelihood of confusion clearly exists.

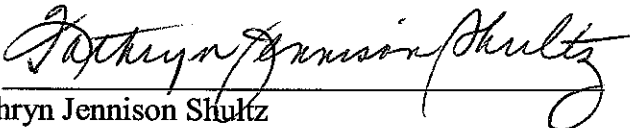
Because the respondent has admitted that he did not use the mark LITTLE RED HEN BAKERY on or in connection with all of the goods listed in the registration when the original use-based application was filed and because the respondent has admitted that he has only sold or distributed his products to customers in the state of Kansas, he has not used his mark in interstate commerce as required by the statute. As a result, the subject registration should be deemed void *ab initio*.

Accordingly, petitioner respectfully requests the granting of its petition and the cancellation of the subject registration.

Respectfully submitted,

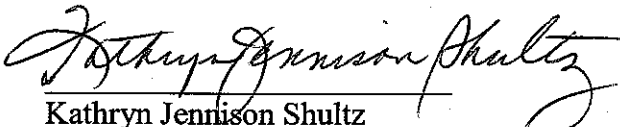
RED HEN BREAD LLC

Date: March 8, 2012

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITIONER'S MAIN BRIEF was served on the Respondent, by forwarding it via First Class Mail, prepaid, to his counsel of record, Robert O. Blinn, Esq., Erickson Kernell Derousseau & Kleypas LLC, P.O. Box 75144, Wichita, Kansas 67275-0144, this 8th day of March, 2012.


Kathryn Jennison Shultz